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In re Application of:
HENDERSON, CHRISTOPHER P. et al
Serial No.: 10/810,958
Filed: Mar. 26, 2004
Attorney Docket No: 59698US002

DECISION ON PETITION

Title: NON-ELASTOMERIC RESPIRATOR
MASK THAT HAS DEFORMABLE
CHEEK PORTIONS

This is a decision on the petition filed on October 2, 2008 requesting a reversal of the examiner's 35 U.S.C. 132 objection to an amendment to the specification which amends definitions of "Mask body" and "Rigid insert" on page 4 of the specification.

The petition is DISMISSED.

The record shows the following relevant facts:

1. On May 24, 2007, applicant filed an amendment to the current application, including amendments on page 4 of the specification regarding modified definitions of "mask body" and "rigid insert".
2. On June 18, 2007, the examiner objected to the amended definitions of "mask body" and "rigid insert" as new matter under 35 U.S.C. § 132.
3. On September 27, 2007, applicant filed a request for reconsideration stating that the amendment in the specification was supported by originally filed disclosure and is not new matter.
4. On December 12, 2007, the examiner issued a Final Office Action again objecting to the specification amendment as new matter not supported by the original disclosure.
5. The applicant filed a RCE on July 9, 2008 and requested re-open prosecution.
6. On September 23, 2008, the examiner issued a Non-final Office action, *inter alia*, again objecting to the specification amendment as new matter not supported by the original disclosure.
7. On October 2, 2008, the current petition was filed seeking the withdrawal of the holding of new matter.

Applicable Statutes, Rules and Regulations

35 U.S.C. § 132 states in relevant part: "No amendment shall introduce new matter into the disclosure of the invention."

MPEP § 608.04(c) states in relevant part: "Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancellation is by way of petition."

Discussion

The applicant attempted to make an amendment to the specification May 24, 2007. The amendment in question states:

"Mask body" means the part(s) of a respiratory mask that extends in spaced relation away from a wearer's face during use and over their a structural member that is configured to fit over a person's nose and mouth to help and that helps define an interior gas space that is separate from an exterior gas space;
"Rigid insert" refers to a relatively stiff structural member that has been used on respiratory masks to provide adequate structure for attaching fluid communication components such as filter cartridges and exhalation valves while being joined to a more compliant mask body part portion that makes contact with and generally conforms to a wearer's face.

Comparing the added portion of the language (added words by underlined) and the removed portions of the language (deleted words by strikethrough line) in the amendment to the specification, there are differences in meaning.

The question in this petition is whether or not the amended specification is new matter under 35 U.S.C. § 132. The Section 132 of 35 U.S.C. does not allow new matter to be disclosed in the specification because it would be improper to change to scope of the specification outside the original disclosure. Petitioner is of the opinion that the May 24, 2007 amendment is not new matter under 35 U.S.C. 132.

In the petition, petitioner in essence argues that applicants' amendment to the definitions of mask body and rigid insert has only made explicit what has been otherwise already disclosed in the originally filed specification and drawings. Therefore, the objection to these modified definitions are not modifications that would constitute new matter under the terms of 35 USC § 132. Petitioner also points to the original specification at page 3, lines 29-31 and page 4, lines 8-12 and in Figures 1-3 and at pages 5-9 and 11-13 to show the support of the modified definitions. In particular, the original definition of mask body further indicates that the mask body is a structural member that is configured to fit over a person's nose and mouth to help define an interior gas space separate from an exterior gas space. In view of the originally filed drawings, description in the specification and the language used in the original definitions, petitioner believes the present modified definition of mask body does not constitute new matter.

A careful study of the mask body definition found on page 3 lines 29-31, the specification only states "Exterior gas space means the ambient atmospheric gas space that surrounds a mask body when worn on a person and that ultimately receives exhaled gas after it exits the interior gas space of a mask". Nothing is mentioned about the parts of respiratory mask that extends in spaced relation away from wearer's face during use and over their nose and mouth. In reference to support for this mask body definition found on page 4 lines 8-12, the specification only recites "Mask body means a structural member that is configured to fit over a person's nose and mouth and that helps define an interior gas space separate from an exterior gas space". Nothing is mentioned about the parts of respiratory mask that extends in spaced relation away from wearer's face during use and over their nose and mouth. In reference to support for this mask body definition found on page 5 lines 9 and 10, the specification describes "Mask 10 fits over a wearer's nose and mouth of a person but not over their eyes, and hence is often referred to as a half mask". Nothing is mentioned about the parts of respiratory mask that extends in spaced relation away from wearer's face during use and over their nose and mouth. Furthermore, none of the figures show parts of respiratory mask that extends in spaced relation away from wearer's face during use the arrows in figures 2 and 3 indicate towards the users face not away from the wearer's face as defined.

In the petition, in essence petitioner argues that the definition of rigid insert can be found on page 1 of the specification at lines 17-31 and in the original definition at page 4, lines 19-22. The applicants have only changed the term "portion" to "mask body part". The new language "mask body part" merely improves upon the original "portion" wording. As such, petitioner does not believe the revised definition of rigid insert could constitute new matter.

A careful study of the rigid insert definition found on page 1 lines 17-31, there is no mention of "mask body part" at all. In reference to support for this rigid insert definition found on page 4 lines 19-22, the specification recites "Rigid insert refers to a relatively stiff structural member that has been used on respiratory masks to provide adequate structure for attaching fluid communication components such as filter cartridges and exhalation valves while being joined to a more compliant portion that makes contact with and generally conforms to a wearer's face". Again, no mention of mask body part.

Based on the above analysis, the added modified definitions of mask body and rigid insert do change the scope of the disclosure, and therefore constitutes new matter. 35 U.S.C. § 132 prohibits new matter in an amendment to the disclosure, so the examiner correctly objected to the amendment to the disclosure.

Conclusion

For the foregoing reasons, the relief requested by petitioner cannot be granted. Specifically, the examiner correctly objected to the amendment to the specification since it added new matter to the disclosure.

The application is being forwarded to the examiner via the Supervisory Patent Examiner of Art Unit 3772 for consideration of the 37 CFR 1.111 amendment filed on December 18, 2008.

Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181".

PETITION DISMISSED.



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